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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/917,971

Applicant(s)

MENTAK, KHALID

Examiner

Tatyana Zalukaeva

Art Unit

1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 33-37.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Tatyana Zalukaeva
Tatyana Zalukaeva
Primary Examiner
Art Unit: 1713

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons set forth in the Final Office Action on the merits. Applicant again argue that tetraethyleneglycol-bis-methacrylate (also referred to as tetraethyleneglycol-dimethacrylate CTEGDMA") cannot be considered a high water content hydrogel forming monomer as set forth in the present claims. In response to Applicant's arguments in the previous response, the Examiner stated that: Applicants do not name the high water content hydrogel forming comonomer in (the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into claims" (see page 5 of Office Action; and The references cited in PTOL- 892 (U.S. Patent No. 5,453,530 issued to Byerley et al. and U.S. Patent No. 4,962, 170 issued to Chromecek et al. submitted along with this Office Action show that tetraethyleneglycol-bis-methacrylate is a hydrogel forming high water content monomer.

As to the Examiner's first point, the limitation of the third monomer being a high water content hydrogel forming monomer" is not cited into" the claims, but rather is specifically recited in claim 33, on which all the remaining claims depend. Applicant has chosen to claim a constituent of the copolymer used in the method in this manner. Applicant further refers to MPEP 2173.01 of fundamental principle contained in 35 U.S.C. 112 second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. Resuming the argument, "Applicant is under no obligation to claim specific high water content monomers in the application when the scope of the invention is not so limited" Examiner agrees that Applicant can be his or her own lexicographer, however, to this end, Applicants is reminded that the identity required for anticipation is between the claimed subject matter and the subject matter disclosed by the reference; identity does not require the reference to disclose the same subject matter as described in the specification. See *Kalman vs. Kimberly Clark Corp.* 218 USPQ 781 (Fed. Cir.1983). In is further noted that "[A]n Examiner has the duty to police the claim language by giving it the broadest possible interpretation", *Springs Window Fashions LP v. Novo Industries L.P.*, 65, USPQ 2d 1826, 1830 (Fed. Cir. 2003). Furthermore, [A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art...". In re *Morris*, 44 USPQ 2d 1023,1027 (Fed. Cir. 1997). In light of the above the hydrogel forming or high water content monomer, as broadly claimed in the instant claim 33) is given its broadest and commonest interpretation, and the reference to Byerley, for instance, provides the interpretation of the 3-d monomer, as used in *Stoy*: For example, when a crosslinked polymer capable of forming a hydrogel is desired, the comonomer can be one or more of di(ethylene glycol) diacrylate, di(ethylene glycol) dimethacrylate, tri(ethylene glycol) diacrylate, tri(ethylene glycol) dimethacrylate, tetra(ethylene glycol) diacrylate and tetra(ethylene glycol) dimethacrylate. (col.9, lines 32-40)